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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/236,552

Applicant(s)

TOMIDA, WATARU

Examiner

Joseph R. Pokrzywa

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 5. 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The references listed in the Information Disclosure Statement submitted on 3/2/99 and 5/19/00 have been considered by the examiner (see attached PTO-1449's).

Drawings

3. The drawings are objected to because of the problems discussed in the attached PTO-948, and also because of:

In Fig. 4, step S60, "INOPUT" should read "INPUT";

In Fig. 5, step S140, "LITLE" should read "TITLE";

In Fig. 9, step S750, "AUTONATICALLY" should read "AUTOMATICALLY";

In Fig. 11, step S990, "MALCE" should read "MAKE".

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1, 12, 13, and 20** are rejected under 35 U.S.C. 102(b) as being anticipated by Kulakowski (WIPO Publication Number WO 97/10668).

Regarding **claim 1**, Kulakowski discloses an internet facsimile device (see Figs. 1 through 3) comprising a means (keypad 41 or 58, page 10, line 31 through page 11, line 10) for specifying an electronic mail address of a destination (page 12, lines 5 through 11), means (scanner 54, page 11, lines 1 through 7) for generating image data by reading an image from an original document (page 12, lines 15 through 21), means (CPU 33 or 46, page 9, lines 31 through 35) for generating electronic mail data based on the image data (page 14, lines 1 through 36), means (data/fax modem 40 or 50, page 10, lines 13 through 30) for transmitting the electronic mail data via an internet to the electronic mail address specified by the destination specifying

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means (page 15, lines 1 through 17), and means (keypad 41 or 58) for inputting a title (text 86, seen in Fig. 4) for the electronic mail data (page 14, lines 8 through 11), wherein the internet facsimile transmitting means comprises title attaching means (CPU 33) for attaching the title as an electronic mail title to the electronic mail data (page 14, lines 13 through 19) before the electronic mail data is transmitted (see Fig. 5, steps 80 through 96).

Regarding *claim 12*, Kulakowski discloses an internet facsimile device (see Figs. 1 through 3) comprising a means (keypad 41 or 58, page 10, line 31 through page 11, line 10) for specifying one of a facsimile number and an electronic mail address as a destination (page 12, lines 5 through 11), means (scanner 54, page 11, lines 1 through 7) for generating image data by reading an image from an original document (page 12, lines 15 through 21), means (CPU 33 or 46) for generating facsimile data based on the image data (page 11, lines 3 through 30, and page 12, lines 18 through 27), means (CPU 33 or 46, page 9, lines 31 through 35) for generating electronic mail data based on the facsimile data (page 14, lines 1 through 36), means (data/fax modem 40 or 50, page 10, lines 13 through 30) for transmitting the facsimile data via a public network to the facsimile number when the facsimile number has been specified as the destination (page 15, lines 18 through 35), means (data/fax modem 40 or 50, page 10, lines 13 through 30) for transmitting the electronic mail data via an internet to the electronic mail address when the electronic mail address has been specified as the destination (page 15, lines 1 through 17), and means (keypad 41 or 58) for inputting a title (text 86, seen in Fig. 4) for the electronic mail data when the electronic mail address has been specified as the destination (page 14, lines 8 through 11), wherein the second facsimile transmitting means comprises title attaching means (CPU 33)

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for attaching the title to the electronic mail data (page 14, lines 13 through 19) before the electronic mail data is transmitted (see Fig. 5, steps 80 through 96).

Regarding **claim 13**, Kulakowski discloses the device discussed above in claim 12, and further teaches that the third data generating means comprises means (CPU 33 or 46, page 9, lines 31 through 35) for converting a format of the facsimile data into a format of electronic mail data (page 14, lines 1 through 36).

Regarding **claim 20**, Kulakowski discloses a method (see Fig. 5) of controlling an internet facsimile device (see Figs. 1 through 3) comprising the steps of specifying an electronic mail address of a destination (page 12, lines 5 through 11), generating image data by reading an image from an original document (page 12, lines 15 through 21), generating electronic mail data based on the image data (page 14, lines 1 through 36), specifying a title (text 86, seen in Fig. 4) for the electronic mail data (page 14, lines 8 through 11), attaching the title as an electronic mail title to the electronic mail data (page 14, lines 13 through 19), and transmitting the electronic mail data attached with the electronic mail title via an internet to the electronic mail address (page 15, lines 1 through 17).

6. **Claims 14 and 21** are rejected under 35 U.S.C. 102(e) as being anticipated by Ho *et al.* (U.S. Patent Number 5,805,298).

Regarding **claim 14**, Ho discloses an internet facsimile device (communications device 100, seen in Figs. 1 and 2) comprising means (fax/data modem 212) for receiving via an internet (112) at least one set of electronic mail data attached with an electronic mail title ("Re:" field, having identification of the subject matter of the message, column 8, lines 32 through 37), means

(display 208) for displaying the electronic mail title (column 8, lines 18 through 37), means (keyboard 206) for selecting electronic mail data from the at least one set of electronic mail data based on the electronic mail title (column 8, lines 26 through 45), and means (printer 210) for forming an image based on electronic mail data selected by the data selecting means (column 8, lines 38 through 50).

Regarding *claim 21*, Ho discloses a method (see Fig. 4) of controlling an internet facsimile device (communications device 100, seen in Figs. 1 and 2) comprising the steps of receiving electronic mail attached with a header from a remote internet facsimile device (column 8, lines 18 through 50, wherein the fields "To", "From", "cc", "bc", and "RE:" are in the header of the electronic mail), with the header including a title ("Re:" field, having identification of the subject matter of the message, column 8, lines 32 through 37), reading the title from the header (column 8, lines 18 through 37, being inherent in the operation of obtaining the e-mail messages stored in the mailbox), displaying the title (column 8, lines 18 through 37), and forming an image based on the electronic mail when requested by a user (column 8, lines 26 through 67).

7. **Claims 14, and 16 through 19** are rejected under 35 U.S.C. 102(e) as being anticipated by Foladare *et al.* (U.S. Patent Number 5,978,837).

Regarding *claim 14*, Foladare discloses an internet facsimile device (personal computer 70, seen in Figs. 1-3) comprising means for receiving via an internet (column 1, lines 18 through 41, and column 2, lines 54 through 67) at least one set of electronic mail data attached with an electronic mail title (column 3, lines 8 through 16), means for displaying the electronic mail title (column 43 through 63), means for selecting electronic mail data from the at least one set of

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electronic mail data based on the electronic mail title (column 3, line 56 through column 4, line 8), and means for forming an image based on electronic mail data selected by the data selecting means (column 3, lines 21 through 25).

Regarding *claim 16*, Foladare discloses the device discussed above in claim 14, and further teaches of means for determining whether or not each one of the at least one set of electronic mail data has a high priority based on a corresponding electronic mail title (column 3, lines 8 through 25, and column 4, lines 37 through 62), and means for notifying the user of electronic mail data having the high priority (column 4, line 63 through column 5, line 6).

Regarding *claim 17*, Foladare discloses the device discussed above in claim 14, and further teaches of means for determining whether or not a priority of each one of the at least one set of electronic mail data is high based on a corresponding electronic mail title (column 3, lines 8 through 25, and column 4, lines 37 through 62), wherein the image forming means forms an image based on the electronic mail data which has been determined to have a high priority (column 3, lines 11 through 25).

Regarding *claim 18*, Foladare discloses the device discussed above in claim 17, and further teaches of means for notifying a user when the image forming means forms an image based on the electronic mail data which has been determined to have a high priority (column 4, line 37 through column 5, line 6).

Regarding *claim 19*, Foladare discloses the device discussed above in claim 17, and further teaches that the priority determining means determines that a priority is high when corresponding electronic mail title contains a predetermined character (column 4, lines 37 through 51).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski (WIPO Publication Number WO 97/10668) in view of Nelson (U.S. Patent Number 6,061,718).

Regarding **claim 2**, Kulakowski discloses the device discussed above in claim 1, but fails to specifically teach if the title inputting means prompts a user to input a title. Nelson discloses an internet messaging device (mobile station 30) comprising a means for specifying an electronic mail address of a destination (column 7, lines 18 through 27), means for generating image data (column 6, line 53 through column 7, line 33), means for generating electronic mail data based on the image data (column 6, lines 55 through 62), means for transmitting the electronic mail data via an internet to the electronic mail address specified by the destination specifying means (column 6, lines 58 through 62, see Fig. 3), and means for inputting a title (subject heading) for the electronic mail data (column 7, lines 25 through 30). Further, Nelson teaches that the title inputting means comprises means for prompting a user to input a title (column 7, lines 25 through 30). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Nelson's teachings in the system of Kulakowski. Kulakowski's system would become more user friendly with the addition of Nelson's teachings, as the user would know when to input subject data for the electronic mail message, as recognized by Nelson.

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10. **Claims 3 through 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski (WIPO Publication Number WO 97/10668) in view of Nelson (U.S. Patent Number 6,061,718), and further in view of Weikart *et al.* (U.S. Patent Number 6,212,535).

Regarding **claim 3**, Kulakowski and Nelson disclose the device discussed above in claim 2, but fail to specifically teach if the title inputting means stores a default title, and sets the default title as the electronic mail title when a user does not input a title. Weikart discloses an internet device (client 110, see Fig. 1, column 2, line 34 through column 3, line 5) comprising a means for specifying an electronic mail address of a destination ("To" field 710 in Fig. 7, column 5, lines 13 through 19, and see Figs. 2, 4A, and 4B), means for generating image data (column 2, line 48 through column 3, line 13), means for generating electronic mail data based on the image data (see abstract, and column 29 through 44), means for transmitting the electronic mail data via an internet to the electronic mail address specified by the destination specifying means (column 4, line 60 through column 5, line 7, and column 5, lines 39 through 44), and means for inputting a title ("subject" header) for the electronic mail data (column 5, lines 16 through 19, seen in Fig. 7). Further, Weikart teaches of a means for storing a default title (column 5, lines 16 through 19), and means for setting the default title as the electronic mail title (column 5, lines 2 through 19) when a user does not input a title (being inherent in the meaning of a "default" subject header). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Weikart's teachings in Kulakowski and Nelson's system. Kulakowski and Nelson's system would become more user friendly with the addition of Weikart's teachings, as having a subject heading set as a default allows a user to enter the data

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in the header once, with the system retaining the information for future mailings, as recognized by Weikart.

Regarding *claim 4*, Kulakowski and Nelson disclose the device discussed above in claim 2, and further teaches that the title inputting means further comprises means for storing at least one title, and means for selecting a title from the at least one title as the electronic mail title. Weikart discloses an internet device (client 110, see Fig. 1, column 2, line 34 through column 3, line 5) comprising a means for specifying an electronic mail address of a destination ("To" field 710 in Fig. 7, column 5, lines 13 through 19, and see Figs. 2, 4A, and 4B), means for generating image data (column 2, line 48 through column 3, line 13), means for generating electronic mail data based on the image data (see abstract, and column 29 through 44), means for transmitting the electronic mail data via an internet to the electronic mail address specified by the destination specifying means (column 4, line 60 through column 5, line 7, and column 5, lines 39 through 44), and means for inputting a title ("subject" header) for the electronic mail data (column 5, lines 16 through 19, seen in Fig. 7). Further, Weikart teaches that the title inputting means further comprises means for storing at least one title ("Subject field 720, having a default header information, column 5, lines 13 through 19), and means for selecting a title from the at least one title as the electronic mail title (see Fig. 7, column 5, lines 2 through 19). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Weikart's teachings in Kulakowski and Nelson's system. Kulakowski and Nelson's system would become more user friendly with the addition of Weikart's teachings, as having a subject heading set as a default allows a user to enter the data in the header once, with the system retaining the information for selection into future mailings, as recognized by Weikart.

Regarding *claim 5*, Kulakowski, Nelson, and Weikart disclose the device discussed above in claim 4, and Weikart further teaches that the title inputting means comprises means for storing a default title (column 5, lines 16 through 19), and means for setting the default title as the electronic mail title (column 5, lines 2 through 19) when a user does not select a title from the at least one title (being inherent in the meaning of a “default” subject header). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Weikart’s teachings in Kulakowski and Nelson’s system. Kulakowski and Nelson’s system would become more user friendly with the addition of Weikart’s teachings, as having a subject heading set as a default allows a user to enter the data in the header once, with the system retaining the information for future mailings, as recognized by Weikart.

Regarding *claim 6*, Kulakowski, Nelson, and Weikart disclose the device discussed above in claim 4, and Weikart further teaches of means for editing the at least one title stored in the title storing means (see Fig. 7, column 5, lines 2 through 19). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Weikart’s teachings in Kulakowski and Nelson’s system. Kulakowski and Nelson’s system would become more user friendly with the addition of Weikart’s teachings, as having a subject heading set as a default allows a user to enter the data in the header once, with the system retaining the information for future mailings, as recognized by Weikart.

Regarding *claim 7*, Kulakowski, Nelson, and Weikart disclose the device discussed above in claim 6, and Weikart further teaches that the title editing means adds a new title to the at least one title (see Fig. 7, column 5, lines 2 through 19, whereby a user can add a new default subject). Therefore, it would have been obvious to a person of ordinary skill in the art at the time

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the invention was made to include Weikart's teachings in Kulakowski and Nelson's system. Kulakowski and Nelson's system would become more user friendly with the addition of Weikart's teachings, as having a subject heading set as a default allows a user to enter the data in the header once, with the system retaining the information for future mailings, as recognized by Weikart.

Regarding *claim 8*, Kulakowski, Nelson, and Weikart disclose the device discussed above in claim 6, and Weikart further teaches that the title editing means modifies selective one of the at least one title (see Fig. 7, column 5, lines 2 through 19). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Weikart's teachings in Kulakowski and Nelson's system. Kulakowski and Nelson's system would become more user friendly with the addition of Weikart's teachings, as having a subject heading set as a default allows a user to enter the data in the header once, with the system retaining the information for future mailings, as recognized by Weikart.

Regarding *claim 9*, Kulakowski, Nelson, and Weikart disclose the device discussed above in claim 6, and Weikart further teaches that the title editing means deletes selective one of the at least one title (see Fig. 7, column 5, lines 2 through 19, wherein the user can create a new default subject, thereby erasing the old default subject). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Weikart's teachings in Kulakowski and Nelson's system. Kulakowski and Nelson's system would become more user friendly with the addition of Weikart's teachings, as having a subject heading set as a default allows a user to enter the data in the header once, with the system retaining the information for future mailings, as recognized by Weikart.

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11. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski (WIPO Publication Number WO 97/10668) in view of Weikart *et al.* (U.S. Patent Number 6,212,535).

Regarding *claim 10*, Kulakowski discloses the device discussed above in claim 1, but fails to specifically teach if the title inputting means stores a default title, and sets the default title as the electronic mail title. Weikart discloses an internet device (client 110, see Fig. 1, column 2, line 34 through column 3, line 5) comprising a means for specifying an electronic mail address of a destination ("To" field 710 in Fig. 7, column 5, lines 13 through 19, and see Figs. 2, 4A, and 4B), means for generating image data (column 2, line 48 through column 3, line 13), means for generating electronic mail data based on the image data (see abstract, and column 29 through 44), means for transmitting the electronic mail data via an internet to the electronic mail address specified by the destination specifying means (column 4, line 60 through column 5, line 7, and column 5, lines 39 through 44), and means for inputting a title ("subject" header) for the electronic mail data (column 5, lines 16 through 19, seen in Fig. 7). Further, Weikart teaches of a means for storing a default title (column 5, lines 16 through 19), and means for setting the default title as the electronic mail title (column 5, lines 2 through 19). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Weikart's teachings in Kulakowski's system. Kulakowski's system would become more user friendly with the addition of Weikart's teachings, as having a subject heading set as a default allows a user to enter the data in the header once, with the system retaining the information for future mailings, as recognized by Weikart.

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12. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski (WIPO Publication Number WO 97/10668) in view of Baran (U.S. Patent Number 5,247,591).

Regarding *claim 11*, Kulakowski discloses the device discussed above in claim 1, but fails to specifically teach if the title inputting means recognizes character data from the image data, with the character data being read from a predetermined position of the original document, and setting the character data as the electronic mail title. Baran discloses a facsimile device (see Fig. 4, fax server 42) comprising a means for specifying an electronic mail address of a destination ("To" field of cover sheet seen in Fig. 1, column 5, lines 31 through 41), means for generating image data by reading an image from an original document (column 5, lines 31 through 60), means for generating electronic mail data based on the image data (column 8, lines 3 through 15), means for transmitting the electronic mail data to the electronic mail address specified by the destination specifying means (column 6, lines 1 through 20, and column 8, lines 3 through 15, and seen in Fig. 4), and means for inputting a title ("Subject" field of cover sheet seen in Fig. 1) for the electronic mail data (see Fig. 1). Further, Baran teaches that the title inputting means comprises means for recognizing character data from the image data (see Fig. 1, and column 6, lines 1 through 34), with the character data being read from a predetermined position of the original document (see Fig. 1, and column 3, lines 17 through 55), and means for setting the character data as the electronic mail title (column 5, lines 31 through 60, and column 8, lines 3 through 56, seen in Fig. 9). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Baran's teachings in Kulakowski's system. Kulakowski's system would become more automated by including the teachings of Baran, as the system would recognize hand written characters in selected fields on

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an incoming facsimile document and automatically write the characters in the selected fields of outgoing e-mail data, as recognized by Baran.

13. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ho *et al.* (U.S. Patent Number 5,805,298) in view of Kulakowski (WIPO Publication Number WO 97/10668).

Regarding **claim 15**, Ho discloses the device discussed above in claim 14, and further teaches of means for receiving facsimile data via a public network (PSTN 106, seen in Fig. 1), wherein the image forming means forms an image based on the facsimile data received via the public network (column 5, lines 24 through 39). However, Ho fails to specifically teach of *means for converting the at least one set of the electronic mail data into facsimile data*, wherein the image forming means forms an image based on the facsimile data received via the public network and on the facsimile data converted from the at least one set of the electronic mail data. Kulakowski discloses an internet facsimile device (see Figs. 1 through 3) comprising means for receiving via an internet (page 8, lines 10 and 11) at least one set of electronic mail data attached with an electronic mail title (page 18, lines 1 through 31), means for displaying the electronic mail (page 18, lines 21 through 23), means for selecting electronic mail data from the at least one set of electronic mail data based on the displayed electronic mail (page 18, lines 23 through 26), and means for forming an image based on electronic mail data selected by the data selecting means (page 18, lines 23 through 29). Further, Kulakowski teaches of means for receiving facsimile data via a public network (see Fig. 8, "yes" at step 138, page 19, lines 24 through 34), and means for converting the at least one set of the electronic mail data into facsimile data (step 162, page 20, lines 33 through 35), wherein the image forming means forms an image based on

the facsimile data received via the public network and on the facsimile data converted from the at least one set of the electronic mail data (step 150 in Fig. 8, page 20, line 35 through page 21, line 2). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's teachings in Ho's system. Ho's system would easily be modified to include the teachings of Kulakowski, as the systems share cumulative features, being additive in nature.

14. **Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ho *et al.* (U.S. Patent Number 5,805,298) in view of Foladare *et al.* (U.S. Patent Number 5,978,837).

Regarding **claim 22**, Ho discloses the method discussed above in claim 21, but fails to particularly teach of determining whether or not the electronic mail belongs to a predetermined group based on the title, and notifying a user of an urgent mail when the electronic mail belongs to the predetermined group. Foladare discloses a method of controlling an internet facsimile device (email server 60) comprising the steps of receiving electronic mail attached with a title from a remote internet facsimile device (column 3, lines 8 through 35), reading the title (column 3, lines 56 through 60), displaying the title (column 3, lines 56 through 60), and forming an image based on the electronic mail when requested by a user (column 3, lines 16 through 63). Further, Foladare teaches of determining whether or not the electronic mail belongs to a predetermined group based on the title (column 3, lines 8 through 25, and column 4, lines 37 through 62), and notifying a user of an urgent mail when the electronic mail belongs to the predetermined group (column 4, line 63 through column 5, line 6). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include

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Foladare's teachings in Ho's system. Ho's system would become more user friendly with the addition of Foladare's teachings, as the user would be notified when an urgent or priority e-mail message has been received, as recognized by Foladare.

Citation of Pertinent Prior Art

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Okutomi *et al.* (U.S. Patent Number 6,211,972) discloses a system that converts between facsimile data and electronic mail data, wherein the electronic mail data includes a "Subject" field in the header;

Bloomfield (U.S. Patent Number 6,025,931) discloses a system that transmits facsimile data as e-mail data, wherein the e-mail data includes a "Subject" field in a header;

Hochman (U.S. Patent Number 5,838,685) discloses a system that transmits facsimile data as an e-mail;

Cooper *et al.* (U.S. Patent Number 5,465,167) discloses a system of creating a form for delivery using a scanned cover sheet with various fields that can be filled in by a user.

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Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J. R. P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp
January 25, 2002


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